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09/944,209	09/04/2001	Roland Callens	32232-175096	4220

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EXAMINER

MAIER, LEIGH C

ART UNIT	PAPER NUMBER
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1623

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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JUL 22 2003
GROUP 2800 (600)

Paper No. 16

Application Number: 09/944,209
Filing Date: September 04, 2001
Appellant(s): CALLENS ET AL.

Ashley I. Pezzner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 16, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Appellants state that they are not aware of any related appeals or interferences involving this application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct. Appellants cite page 4, line 30 through page 5, line 10 of the specification for description of the invention. It is noted that this passage does not describe a compound having the "R³-NH" moiety comprised in the instant structural formula.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 7, 18, and 22-27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claims 7, 18, and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 7 was amended to include the limitation “. . . in which R³-N^αH represents an α-amino acid [or a peptide comprising the α-amino acid] and N^α is a nitrogen atom attached to the α-carbon of the α-amino acid.” (*The text in brackets was deleted by amendment after final. The underlined text was added by amendment and is the text that is considered to be new matter.*) The original “R³-NH” moiety is described at page 8, lines 23-24: “R³-NH is preferably an amino acid and more preferentially an essential amino acid.” In further limiting “amino acids,” this passage does not support the limitation of all α-amino acids. The description supports only the further limitation of “essential amino acids.”

(11) Response to Argument

Appellants argue that there is support for this limitation bridging pages 1 and 2 and examples 1 and 2, with additional support at page 8, lines 23-24, repeating the same sentence

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cited above: "R³-NH is preferably an amino acid and more preferentially an essential amino acid."

The paragraph bridging pages 1 and 2 is a general discussion of the definition of amino acids, particularly as it relates to the general formula at page 2, line 2. There is no discussion of the R³-NH moiety in this passage.

Appellants contend that the cited passages clearly contemplate amino acids other than essential amino acids as the R³-NH group. "Essential amino acid" is an art-recognized term defining a *specific* set of *natural* α -amino acids. The full set of natural α -amino acids is a group of amino acids that is broader than the essential ones. The group of all α -amino acids, natural and unnatural, is vastly broader still. Finally, the term "amino acid," as defined in the instant specification, is infinitely broader than any of these sub-sets. The examiner agrees that the genus of amino acids, *per se*, is disclosed, but this description does not support the limitation of *any particular sub-set* of amino acids, other than essential amino acids.

With regard to examples 1 and 2, Appellants state that the examples disclose compounds in which R³-NH is an α -amino acid with N ^{α} being attached to the α -carbon of the α -amino acid. The α -amino acids in these examples are tryptophan and methionine, respectively. Both of these amino acids are essential amino acids. Therefore, these examples merely exemplify essential amino acids discussed in the specification. The cited examples do not broaden the prior disclosure.

Appellants further contend that examples of all possible α -amino acids, or any examples, are not necessary for the claims to be enabled. The examiner agrees. However, the claims were not rejected for lack of enablement. The issue at hand is lack of written description.

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The claims stand rejected for lack of written description. Appellants' arguments that the added material is adequately described in the specification are not found to be persuasive. Thus, for the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Leigh C. Maier
Examiner
Art Unit 1623

LCM
July 11, 2003

Conferees


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Conferee


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Attachment: PTO-1449 for IDS submitted February 24, 2003, after final rejection. The references have considered, and the PTO-1449 has been initialed.